

only if the cited references, alone or in combination, teach all of the elements of the recited claims. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). For at least the reasons discussed below, the cited and applied references, alone or in combination, fail to disclose or suggest all of the elements recited in the claims and indeed teach away from the present application. The claims should thus be allowed.

II. Claim Rejections Under 35 U.S.C. § 103(a)

A. Independent Claim 1

Claim 1 is directed to a method for communicating information regarding a selected item to a user present at the location of a first retail entity. As recited in Claim 1, the method requires that "while the user remains present at the location of the first retail entity, which first retail entity is different than a second retail entity, the second retail entity: receiv[es] an image from the user using an imaging device, wherein the image contains identifying data associated with the selected item as provided by the first retail entity." The method of Claim 1 further requires the second retail entity to "extract[] identifying information from the image" and "us[e] the identifying data to obtain item information associated with the selected item, wherein the selected item is available for purchase from the second retail entity." These elements in combination are not taught or suggested by Siegel and Kinjo.

Siegel and Kinjo Fail to Teach "Second Retail Entity"

Claim 1 is patentably distinct from the cited art for at least the reason that Siegel and Kinjo fail to teach a "second retail entity" that extracts "identifying data from the image" and uses "the identifying data to obtain item information associated with the selected item" and from which "the selected item is available for purchase," as recited in Claim 1.

The electronic retail network server 104 described by Siegel uses machine-readable UPC code information to obtain pricing information that is available from participating stores and vendors. See, for example, paragraph [0014] of Siegel:

According to one other aspect, location-determining technology is added to the bar code scanning and information retrieval system. The combination of bar code and geographic coordinates can be used to provide location specific information to a consumer. Thus, the present invention enables a user to readily obtain information associated with the vendor *at the location where the product is scanned* (if, for example, this location is a retail establishment) *and other vendors of the scanned product in the vicinity* (e.g., within a number of miles selected by the user) of the scanning device or at any other location of interest. Information can be provided to the user concerning nearby vendor location, maps to these vendors and product pricing and availability at these vendors, for example.

It is important to note that the selected item is not available for purchase from the electronic retail network server 104. Accordingly, the electronic retail network server 104 described by Siegel cannot be considered the "second retail entity" recited in Claim 1. The "second retail entity" in Claim 1 is an entity from which "the selected item is available for purchase."

Instead, according to Siegel, the selected item is available for purchase at the store in which the consumer is located or at nearby participating vendors (Store A, Store B, Store C, etc.). See, e.g., paragraph [0071] of Siegel:

As an example, a customer can scan a UPC symbol 100 of a stereo component at participating Store A using a scanning device 101 associated with an Internet-ready device 102. The device 102 can then contact an electronic retail network server 104 over the Internet and transmit information concerning the UPC code as well as information regarding the global position of the Internet-ready device 102. Using this information, the electronic retail network server 104 can then supply information to the Internet-ready device 102 regarding pricing available at store A, as well as the nearby participating vendors (Store B, Store C, etc.).

The Office Action, at page 3, lines 3-7, cited Siegel at paragraph [0071] as allegedly teaching the "second retail entity" as claimed, but in this regard the Office Action is in error. The electronic retail network server 104 described by Siegel cannot be considered the "second retail entity" recited in Claim 1, as Siegel's electronic retail network server 104 is not an entity from which "the selected item is available for purchase."

As for Kinjo, the Office Action does not allege nor can applicants find any disclosure that could be combined with Siegel to suggest that the electronic retail network server 104 could be considered equivalent to the "second retail entity" as claimed in Claim 1.

Applicants further note that Siegel does not teach or suggest that the store in which the consumer is located or the nearby participating vendors extract identifying information from an image and use that information to obtain item information (e.g., pricing) associated with the selected item. Thus, neither the store nor the nearby participating vendors can be considered equivalent to the "second retail entity" that extracts "identifying data from the image" and uses "the identifying data to obtain item information associated with the selected item," as recited in Claim 1. Additionally, there is nothing in Siegel to suggest that the electronic retail network server 104 itself is equivalent to a store or a participating vendor from which the selected item can be purchased.

Applicants further considered the disclosure in Kinjo and find nothing in Kinjo that could be combined with Siegel to suggest that the store in which the consumer is located or the participating vendors could be considered the "second retail entity," as claimed in Claim 1.

Simply stated, there is no combination of disclosure in Siegel and Kinjo that either teaches or suggests all of the features recited in independent Claim 1. Accordingly, for at least the reasons set forth above, applicants respectfully submit that Claim 1 is patentable over Siegel and Kinjo. Withdrawal of the rejection of Claim 1 is respectfully requested.

B. Dependent Claims 2 and 4-10

As discussed above, Siegel and Kinjo fail to teach all of the features of independent Claim 1. Where dependent Claims 2 and 4-10 ultimately depend from independent Claim 1, Claims 2 and 4-10 are likewise allowable over Siegel and Kinjo for at least the reasons discussed above in connection with Claim 1. Claims 2 and 4-10 are also allowable for the additional subject matter they recite.

C. Dependent Claim 3

As with Claims 2 and 4-10, applicants submit that Claim 3 is patentable over Siegel and Kinjo because of the failure of the references to teach all of the features of independent Claim 1. Additionally, applicants have considered the disclosure of Fitzsimmons with respect to Claim 3, as well as all other pending claims in the present application, and submit that Fitzsimmons does not overcome the deficiency of disclosure in Siegel and Kinjo as discussed herein.

D. Independent Claim 12

Claims 12 and 15-28 were rejected under the same basic rationale as Claims 1, 2, and 4-10. In view of the reasons discussed above with respect to Claim 1, applicants respectfully submit that Siegel and Kinjo fail to teach all of the elements of Claim 12. At a minimum, Siegel and Kinjo fail to teach "a server operated by a second retail entity" having "a subsystem configured to use the identifying data to obtain item information associated with the selected item available for purchase from the second retail entity." Accordingly, Claim 12 is patentable over Siegel and Kinjo. Withdrawal of the rejection of Claim 12 is requested.

E. Dependent Claims 13-21

Dependent Claims 13-21 ultimately depend from independent Claim 12. As discussed above, there is no combination of Siegel and Kinjo that teaches or suggests all of the elements of independent Claim 12. Claims 13-21 also include a number of recitations not disclosed, taught, or suggested by Siegel or Kinjo, particularly when the recitations are considered in combination with the recitations of Claim 12 from which these claims depend. For the above-mentioned reasons, Claims 13-21 are likewise allowable. Withdrawal of the rejections under Section 103 is requested.

F. Independent Claim 22

Claim 22 recites elements similar to those of Claim 1. Accordingly, based on the above analysis of Claim 1, applicants respectfully submit that Siegel and Kinjo, whether considered alone or combined, fail to teach or suggest all of the elements of Claim 22. In particular, Siegel

and Kinjo fail to teach the recited "computer-executable component [that] is executed by a second retail entity" for "extracting the identifying data from the image" and "using the identifying data to obtain item information associated with the selected item, wherein the selected item is available for purchase from the second retail entity." For at least these reasons, the rejection of Claim 22 should be withdrawn.

G. Dependent Claims 23-29

Claims 23-29 are dependent on Claim 22 and, thus, are allowable for the reasons discussed above in connection with Claim 22. Claims 23-29 also include a number of recitations not disclosed, taught, or suggested by Siegel or Kinjo, particularly when the recitations are considered in combination with the recitations of Claim 22 from which these claims depend. For these reasons, Claims 23-29 are patentable over Siegel and Kinjo.

H. Independent Claim 30

Claim 30 includes the feature of "[a]n integrated portable apparatus for obtaining item information for a selected item available for purchase at a location of a first retail entity." The apparatus comprises, among other things, "a processing unit communicatively coupled to the input device, the output device, and the storage medium, for executing the program instructions that process the image by obtaining the item information for the selected item by communicating the image containing the identifying data to the second retail entity, wherein the selected item is available for purchase from the second retail entity." As previously discussed with respect to Claim 1, neither Siegel nor Kinjo discloses communicating the image containing the identifying data to a second retail entity, wherein the selected item is available for purchase from the second retail entity. Although Siegel allegedly teaches that a consumer can scan a UPC code using a scanning device so that an electronic retail network server 104 can receive or download information concerning the item identified by the UPC code, Siegel does not teach that an image containing the identifying data is communicated to a second retail entity at which the selected item is available for purchase. Kinjo, for its part, does not cure the deficiency of disclosure in

Siegel. To the extent Kinjo discloses communicating an image, it does not do so to a second retail entity as claimed. These aspects of Siegel and Kinjo, even if combined, do not render obvious the apparatus claimed in Claim 30 in which the image containing the identifying data is communicated to a second retail entity from which the selected item is available for purchase.

For at least the above reasons, as well as the reasons presented with respect to Claim 1, applicants submit that Claim 30 is patentable over the cited art.

I. Dependent Claims 31-35

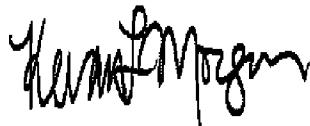
Dependent Claims 31-35 depend from independent Claim 30. As discussed above, both Siegel and Kinjo fail to teach each of the elements of independent Claim 30. Accordingly, Claims 31-35 are likewise patentable over the cited art.

CONCLUSION

In view of the foregoing remarks, applicants submit that all of the pending claims in the application are in condition for allowance. Reconsideration of the application and allowance of the claims is solicited. If the Examiner has any remaining questions or comments concerning this matter, the Examiner is invited to contact applicants' undersigned attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Kevan L. Morgan
Registration No. 42,015
Direct Dial No. 206.695.1712

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100